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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/930,235	02/23/1998	ANJA EITRICH	BEIERSDORF45	2748
27384	7590	05/17/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			METZMAIER, DANIEL S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/930,235

Applicant(s)

EITRICH ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 4-11 are pending.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 4-6 and 9-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Affinity Biotech, Inc., WO 91/18669. Affinity Biotech, Inc (examples) discloses microemulsions having the property of being transparent or translucent and having an oil phase concentration of less than or equal to 11.8% by weight. Affinity Biotech, Inc (page 3, lines 25-26) further points out that it is generally known that "More fatty oil generally requires more emulsifier". Said teaching suggests lower concentration oil phase microemulsions are more easily made than high oil phase microemulsions.

Affinity Biotech, Inc (page 4, lines 29-33; and examples, particularly example 7) further teaches the addition of water-in-oil emulsifiers. Affinity Biotech, Inc makes no distinction between the order of addition of the emulsifiers and the coemulsifiers, said reference contemplates the addition of the water-in-oil emulsifiers followed by the oil-in-water emulsifiers, the oil-in-water emulsifiers followed by the water-in-oil emulsifiers, or the simultaneous addition of emulsifiers into the emulsion.

Furthermore, claim 8 does not define any specific temperature. A microemulsion is defined as a liquid in a liquid. Affinity Biotech, Inc discloses materials, which would at least either melt or dissolve in the oil phase since said reference forms microemulsions.

Applicants have not shown that the particular methods impart a distinction to the compositions. See MPEP § 2113.

5. Claims 7-10 are rejected under 35 U.S.C. 103(a) as obvious over Affinity Biotech, Inc., WO 91/18669. Affinity Biotech, Inc (examples) discloses microemulsions having the property of being transparent or translucent and having an oil phase concentration

of less than or equal to 11.8% by weight. Affinity Biotech, Inc (page 3, lines 25-26) further points out that it is generally known that "More fatty oil generally requires more emulsifier". Said teaching suggests lower concentration oil phase microemulsions are more easily made than high oil phase microemulsions.

Affinity Biotech, Inc (page 4, lines 29-33; and examples, particularly example 7) further teaches the addition of water-in-oil emulsifiers. Affinity Biotech, Inc makes no distinction between the order of addition of the emulsifiers and the coemulsifiers, said reference contemplates the addition of the water-in-oil emulsifiers followed by the oil-in-water emulsifiers, the oil-in-water emulsifiers followed by the water-in-oil emulsifiers, or the simultaneous addition of emulsifiers into the emulsion.

Furthermore, claim 8 does not define any specific temperature. A microemulsion is defined as a liquid in a liquid. Affinity Biotech, Inc discloses materials, which would at least either melt or dissolve in the oil phase since said reference forms microemulsions.

To the extent the sequential use of use of water-in-oil emulsifiers followed by the oil-in-water emulsifiers to the emulsion has not been disclosed in the Affinity Biotech, Inc reference, the sequence of adding materials or the of the selection of any order of performing process steps has been held to be *prima facie* obvious in the absence of new or unexpected result. See MPEP 2144.04(IV)(c).

### ***Response to Arguments***

6. Applicant's arguments filed February 22, 2005 have been fully considered but they are not persuasive.

7. Applicants comments regarding the appearance of the microemulsion have not been deemed persuasive for the following reasons.

(1) Microemulsions are known in the art to have a particle size of less than that of the resolution of an optical microscope, i.e., ~ 0.2 microns or 200 nanometers (nm). This feature is what originally set said compositions apart from other compositions, which have an opaque appearance resulting from the reflection, defraction, and refraction of the light. The examples of the reference disclose emulsion droplet sizes on the order of 25 nm or 30 nm, which is well below the art accepted distinction and within those have a transparent appearance. Attention is directed to Rosen, Surfactants and Interfacial Phenomena, page 224-225.

(2) Applicants' claims do not specify a specific temperature that the emulsions are transparent and translucent. The claims specify that the temperature be below the phase inversion temperature (PIT).

8. Applicants (pages 10 and 11) assert the specification states the prior art emulsions are opaque without evidence of record or a showing of the prior art compositions. Said statement does not rebut the *prima facie* case of anticipation and/or obviousness presented.

9. Applicants (pages 11 and 12) assert the reference does not teach a method without mixing. Applicants (page 23, lines 14-17 of the instant specification prefer to stir the compositions. While the homogenization may be dispensed with, applicants have not shown said step to impart a patentable distinction to scope of the compositions claimed.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.

A handwritten signature in black ink, reading "Daniel S. Metzmaier". The signature is fluid and cursive, with the first name "Daniel" and last name "Metzmaier" clearly legible.

**Daniel S. Metzmaier**  
**Primary Examiner**  
**Art Unit 1712**

DSM